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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/578,277	05/25/2000	Indira C. Prabhakar	5205 P3005.01	6173

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Reising Ethington Barnes Kisselle Learman
& McCulloch P C
5291 Colony Drive North
Saginaw, MI 48603

EXAMINER

PENDLETON, BRIAN T

ART UNIT	PAPER NUMBER
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2644

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/578,277

Applicant(s)

PRABHAKAR ET AL.

Examiner

Brian T. Pendleton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. **Claims 1, 2, and 4-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Newland in view of Sekura et al further in view of Barker.

Regarding **claims 1 and 5**, Newland discloses a medication reminder device comprising ON/OFF button 34 for turning the medication reminder device on, a microphone for recording an oral message that identifies a medication and the dosage to be taken, entering a day and time schedule in the device (in microprocessor 16) for taking a medication, saving the oral message and the day and time schedule and playing the recorded oral message when the time arrives for taking a medication. Newland does not disclose entering a code that provides access to a recording function. Sekura et al disclose a prescription compliance device which, in one embodiment, gives the user the option of locking the programming capabilities of the device. It was advantageous to have the locking feature since unintended alterations of a dosage schedule could result if the program was not locked. A resulting mistake in dosage could lead to serious health problems for the user. Therefore, one would have been motivated to provide the locking feature of Sekura et al, by providing an access code, in the invention of Newland. The combination of Newland and Sekura et al do not specify that the month, date and time of day is entered in the schedule for the medication reminder device. Barker discloses a medical information appliance which sets an alarm for a medical event (dosage time), whereby the alarm is set for the month, date and time of day, as discussed in column 5 line 45 – column 6 line 38. It

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would have been obvious to one of ordinary skill in the art at the time of invention to apply the medical event alarm setting configuration taught by Barker in the combination of Newland and Sekura for the purpose of permitting the user to program a schedule of over a long period thereby increasing the flexibility of the medication reminder system. Barker discloses an alert signal (a beep) in column 7 lines 9-13 when a medical event occurs and one of the buttons (reverse or forward) is used to turn off the alert signal. In the combination of Newland, Sekura and Barker, it would have been obvious to use the audible beep alert signal to alert an individual that it is time to take a medication. Furthermore, it was obvious to replay the recorded oral message after the alert signal to give more specific information about how a medication should be taken. The modified Newland invention, per the teachings of Sekura and Barker, would include generating a signal, playing the oral message whereby the oral message is played in response to a button to turn off the alert signal. One of ordinary skill in the art would have realized, without undue experimentation, the natural order of beeping (alert signal) and further information via recorded voice, as means for patient compliance.

Regarding **claim 2**, Barker discloses multiple alarms which are used to record a dosage schedule for up to 12 medical events. It would have been obvious to one of ordinary skill in the art to provide multiple oral messages for those medical events.

Regarding **claims 4 and 6**, Barker discloses in column 7 lines 37-43 that all of the medical events stored can be displayed. Obviously, one of ordinary skill in the art would have concluded that display would be returned to the current month, date and time after reviewing the medical events. As a result, it was taught to review an existing dosage schedule and return to the current time. As applied to the combination of Newland, Sekura and Barker, it would have been

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obvious to play the oral messages, which are recorded for a future period, and then return to the current time for the purpose of double-checking that the exact medication reminder message is recorded for the user.

3. **Claim 3** is rejected under 35 U.S.C. 103(a) as being unpatentable over Newland in view of Sekura et al further in view of Barker as applied to claim 1 above, and further in view of Kirton et al. The combination of Newland, Sekura et al and Barker does not teach recording a warning message and playing such message when the user does not take action after an alert signal for a scheduled dosage. Nonetheless, that feature was well known in the art at the time of invention. Kirton et al disclose an event monitoring device for medicine compliance. In figure 3 there is disclosed a flow diagram which shows that the user gets alerted several times after the initial alert to take medication. Thus, it was taught to further warn the user that medication has to be taken. The art suggests that single notification was not sufficient. It was advantageous to provide multiple notification since the missing of a dose of medicine could have resulted in grave consequences for the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to provide a system of multiple notification in the combination of Newland, Sekura et al and Barker. Since the Newland invention uses voice messages, modifying the Newland/Sekura et al/Barker combination would involve recording a message that the initial alert was not regarded, thus meeting claim 3.

Response to Arguments

4. Applicant's arguments filed 2/28/05 have been fully considered but they are not persuasive.

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5. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant has not clearly explained how independent claims 1 and 5 are patentable over the combination of Newland, Sekura, and Barker with respect to the claim language. The only argument presented is that one of the references teaches a feature that the Applicant's system does not comprise. However, that does not disqualify that fact that the reference relied upon, Barker, **does teach** features that the Applicant are claiming, specifically, generating a signal to alert an individual that it is time to take a medication and turning off the alert signal with a "play" button whereby the "play" button initiates a detailed dosage message.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case, Applicant has neglected to address the combination of Newland, Sekura and Barker, but rather has pointed to a single passage in Barker.

Continued Examination Under 37 CFR 1.114

7. All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114.

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See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

8. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian T. Pendleton whose telephone number is (571) 272-7527. The examiner can normally be reached on M-F 7-4:30.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Brian T. Pendleton
Examiner
Art Unit 2644



btp

BRIAN PENDLETON
PATENT EXAMINER